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In re Application of	:
Manfred Galle et al	:
Serial No.: 10/620,759	: PETITION DECISION
Filed: July 17, 2003	:
Attorney Docket No.: 029300.52497US	:

This is in response to the petition under 37 CFR 1.144, filed September 6, 2005, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on June 11, 2000, and contained claims 1-18. In a first Office action, mailed September 13, 2004, the examiner set forth a restriction requirement, as follows:

- Group I – Claims 1-13, drawn to a composition;
- Group II – Claims 14-18, drawn to a method for inhibiting maldigestion.

The examiner provided appropriate reasoning for restriction. The examiner indicated that if the product claims were ultimately found allowable, method claims of the same scope would be rejoined.

Applicants replied on September 30, 2004, electing Group I and traversing the restriction requirement on the basis that the process cannot be practiced with another product.

The examiner mailed a new Office action to applicants on December 10, 2004, acknowledging the election of Group I and the traversal and responding thereto, maintaining the requirement for the reasons set forth and making it Final. Claims 1-13 were then rejected under 35 U.S.C. 103(a) over Sipos in view of Ogawa et al.

Applicants replied on March 10, 2005, providing a new claim set (no apparent amendments) and arguing the rejection of record and continuing the traversal of the restriction requirement for the same reasons.

The examiner mailed a Final Office action to applicants on June 6, 2005, maintaining the rejection of record under 35 U.S.C. 103(a) and the restriction requirement for the same reasons as previously set forth..

This petition was filed on September 6, 2005, concurrently with a reply to the Office action. It appears no action has been taken on the reply at present.

DISCUSSION


A review of the restriction requirement shows that the examiner divided the claims according to whether a product or process was being claimed. It is well established that restriction between statutory classes of invention is proper. Nothing in the reasoning of the examiner is improper in justifying the restriction requirement. The examiner has also indicated that rejoinder of method claims with elected product claims will be considered and effected upon determination that the product claims are allowable. Such has not yet happened. Should the product claims be found allowable over the prior art, the method claims will be rejoined and examined with respect to all aspects of the statute to determine their patentability.

DECISION

The petition is **DENIED**.

The application will be forwarded to the examiner for consideration of the amendment after Final rejection filed concurrently with the petition. Applicants remain under obligation to provide an appropriate reply to the Final Office action.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.


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Director, Technology Center 1600